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BERMAN, AISENBERG & PLATT
1730 RHODE ISLAND AVE., N.W.
WASHINGTON, DC 20036-3186

EXAMINER	
FAN, J	
ART UNIT	**PAPER NUMBER**
121	21

DATE MAILED: 09/01/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 1 - 27 are pending in the application.
   Of the above, claims 20, 23 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-19, 21-22, 24-27 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Claims 1-19, 21, 22, 24-27 are again rejected under 35 USC 103 as being obvious over patent no. 4,555,518, or 4,560,693 in view of 4,255,431 for reasons of record. Applicants' declaration submitted July 7, 1987 has been carefully considered, but are deemed unpersuasive for the following reasons:

1. Applicants repeated stated that dialkoxy-substituted pyridine compounds are much stable chemically at PH=5 than mono-alkoxy-substituted pyridine compounds. This stability would indicate less side effect. However, applicants fail to demonstrate that the claimed dialkoxy compounds are equally or more potent in their primary use, which is to inhibit excess gastric acids or providing a protective action for the stomach. It is conceivable that the claimed compounds may be less effective as in inhibiting gastric acid secretion or providing protective action for the stomach, thus greater dosage is required which would offset the advantage of less-side effect of the claimed compounds. Note In re DeMontmollin 145 USPQ 416.

2. The inclusion of compounds 1-3, 10, 19. 22 (c), 27(c) is not understood.

3. It appears the only meaningful data ($-OCH_3$ versus $-CH_3$) are compounds 4. 5; compounds 12. 14; compounds 13, 15; compounds 17, 18; compounds 20. 21; compounds 24, 25; compounds 29. 30. Applicants in the declaration (page 9, last two paragraphs) stated that "it is justified to predict the superiority of the

dialkoxy-substituted pyridines with regard to their stability characteristics ... or chloro-difluoromethoxy". However, it is examiner's position that the comparison ~~reference compounds~~ reference compounds of seven meaningful art compounds out of vast number of is still not commensurate with the scope of the generic claims. Note In re Johnson 223 USPQ 1260.

Claims 1-19, 21, 22. 24-27 are again rejected under obvious-type double patenting rejection over art of record and for the same reason in the previous paragraph.

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The structure of chlorotriflunoethylene dioxy is not clear. Applicants are requested to depict the structure.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as the SN 794,230 reference at the time this invention was made. Accordingly, the SN 794,230 reference is disqualified as prior art through 35 U.S.C. 102(f) or

(g) in any rejection under 35 U.S.C. 103 in this application. However, this reference additionally qualifies as prior art under section e of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103.

Claims 1-19, 21, 22, 24-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending application serial no. 794,230. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

The citation of PTO-1449 and accompanying references submitted on March 3, 1987 are noted. However, the pertinency of these references to the instant application is not seen. Clarification is requested.

Any inquiry concerning this communication should be directed to Examiner Fan at telephone number 703-557-3920.

07/29/87;rbb

Jane T. Fan

JANE T. FAN
PRIMARY EXAMINER
ART UNIT 121